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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,726	10/30/2001	Jose Zayas-Rivera	ALPHA-0200	4495

7590 11/16/2005
Patent Law Offices of Heath W. Hoglund
256 Eleanor Roosevelt
San Juan, PR 00918

EXAMINER

WEDDINGTON, KEVIN E

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,726

Applicant(s)

ZAYAS-RIVERA ET AL.

Examiner

Kevin E. Weddington

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 48-50 is/are allowed.
- 6) ☒ Claim(s) 38-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-3-05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claims 38-50 are presented for examination.

Applicants' amendment and information disclosure statement filed February 3, 2005 have been received and entered.

Accordingly, the rejections made under 35 USC 112, first paragraph as set forth in the previous Office action dated December 17, 2004 at pages 2 and 3 are hereby withdrawn.

The allowance of claims 40-44, 46 and 47 is withdrawn so that the Examiner can suggest better claim formulation for the applicants.

Allowable Subject Matter

Claims 48-50 are allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38, 40 and 43-45 are rendered indefinite by the word "bacteriacide" which is misspelled. The correct spelling is "bactericide". The remaining claims 39, 41, 42, 46 and 47 are rendered indefinite to the extent that they incorporate the above terminology.

Claims 38-47 are not allowed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38 and 39 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Kurita et al., "Antifungal activity and molecular orbital energies of aldehyde compounds from oils of higher plants", *Agricultural Biological Chemistry* (1979), 43(1), pages 2365-2371, of record, for reason of record as set forth in the previous Office action dated December 17, 2004 at pages 3-5 are applied to claims 38 and 39.

Applicants' remarks regarding the prior art, Kurita et al., does not teach the instant composition "for use as a fungicide and a bactericide" comprising perillyl aldehyde are not persuasive since this is an intended use and does not distinguish applicants' claims over the teachings of the prior art. Applicants are reminded of the findings of In re Spada 15 USPQ2d 1655 (CAFC, 1990): "Discovery of new property or use of previously known composition, even if unobvious from prior art, cannot impart patentability to claims to known composition."

The rejection made under 35 USC 103 is adhered to.

To overcome this rejection, the applicants may wish to amend claim 38 by following suggestion:

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Claim 38 should read.

--A fungicide/bactericide composition comprising perillyl aldehyde, wherein the concentration of perillyl aldehyde is sufficient to inhibit the growth of fungi and bacteria, wherein the concentration of perillyl aldehyde is greater than one half of one percent by weight of the composition. —

Applicants may wish to amend claims 40 and 43-45 exactly the same as claim 38 to place the application into a condition for allowance.

For example, claim 40 should read:

--A fungicide/bactericide composition comprising perillyl aldehyde, wherein the concentration of perillyl aldehyde is sufficient to inhibit the growth of fungi and bacteria, wherein the composition further comprises at least one alcohol, and wherein the composition has the consistency of a cream. —

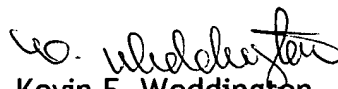
And claims 43-45 the same way along with their respective claim limitations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571)272-0587. The examiner can normally be reached on 11:00 am-7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kevin E. Weddington
Primary Examiner
Art Unit 1614

K. Weddington
November 10, 2005